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No. 718

IN THE

# SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1941

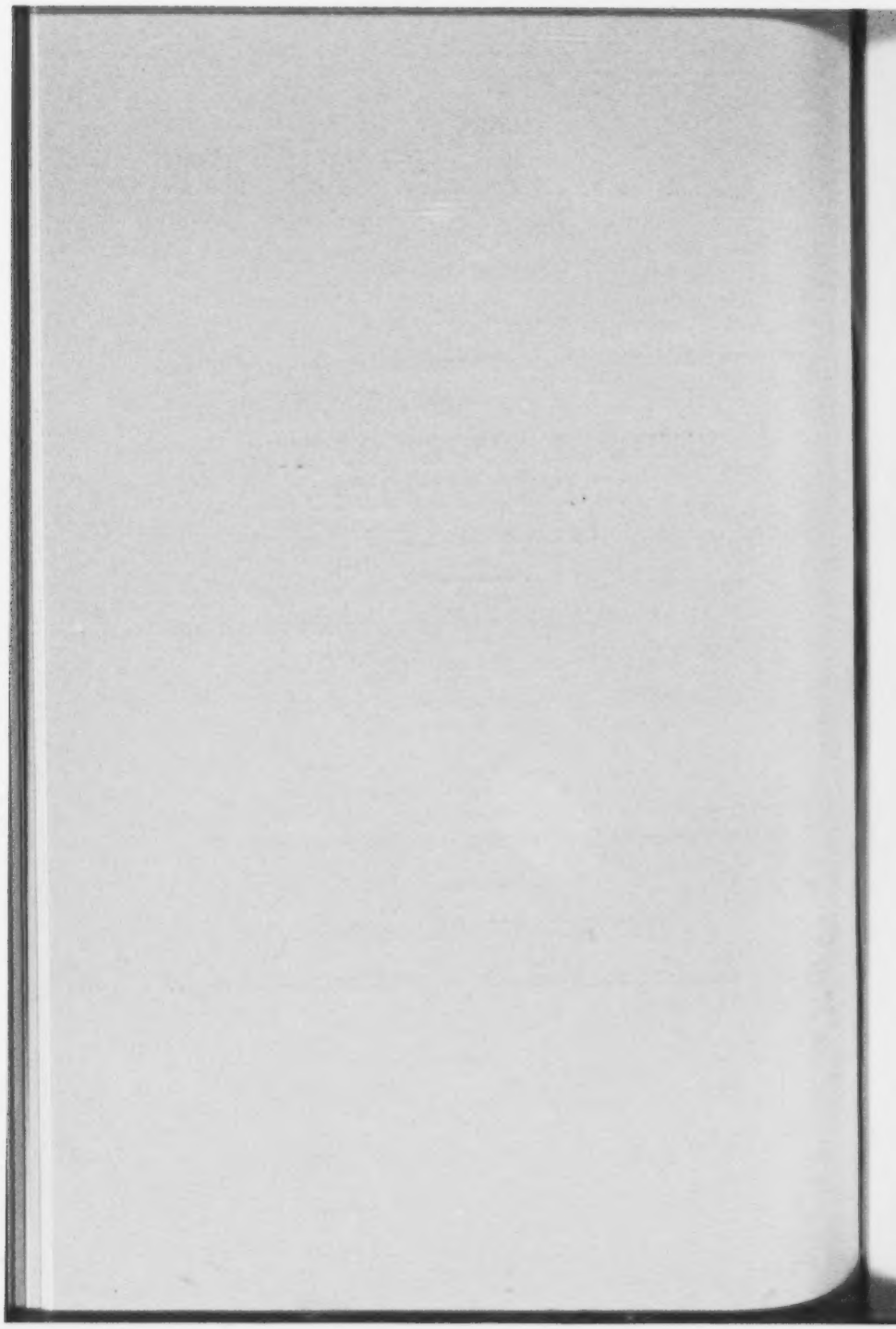
GENERAL MOTORS CORPORATION, PETITIONER

*v.*

CONWAY P. COE, COMMISSIONER OF PATENTS, RESPONDENT

ON PETETION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA

## PETITION FOR REHEARING



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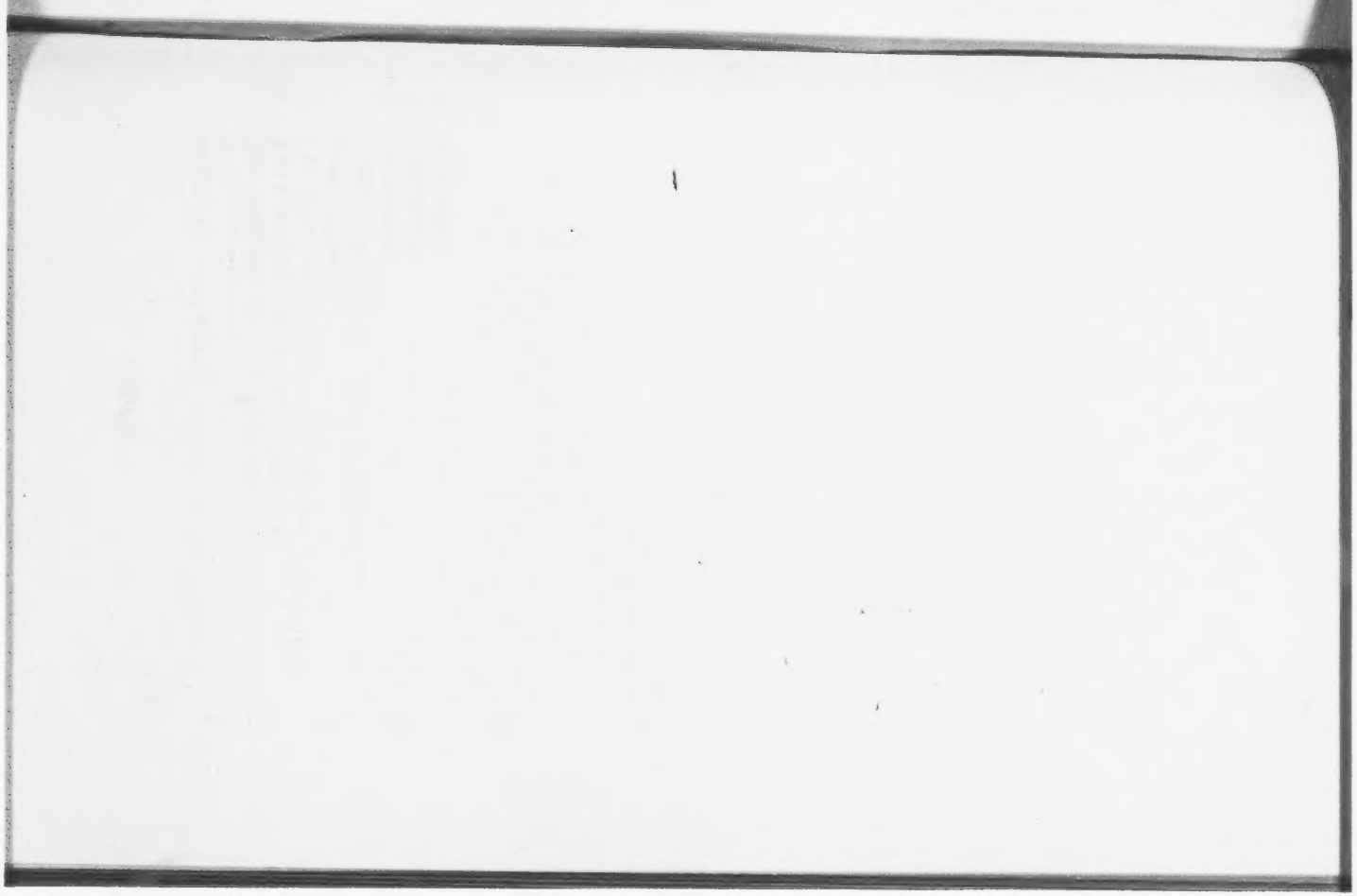

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## REQUEST FOR REHEARING

Petition for certiorari in the above entitled cause was denied November 24th, 1941. Petitioner respectfully presents its request for reconsideration.

## SUMMARY OF REASONS RELIED ON FOR GRANT OF THE WRIT

A review was sought of the decision of the Court of Appeals for the District of Columbia upon a question of law with respect to applications for patents for inventions. In this cause the Court of Appeals made a ruling on the question directly opposite to the law theretofore followed from the beginning in such Court and in the other tribunals dealing with applications for patent. It was not a ruling

of the whole Court and there are differences of opinion today in the Court itself as to which of the two directly opposite rules is the proper rule. A ruling on the question by another United States Court of Appeals is impossible. This Court has not ruled on the precise question but the ruling of the Court of Appeals for the District of Columbia is in direct conflict with the rulings of this Court on a question which comprehends the question of law involved in this case. The ruling of the Court of Appeals makes it more difficult to get a patent than to sustain one. The question at issue is of great importance to inventors, all industry, large and small, and the country as a whole. Unless the ruling of the Court of Appeals in this case is revised by this Court it will, we predict, lead to the destruction of the patent system in this country. Public interest requires an early settlement of the conflict in rulings.

## THE REASONS FOR THIS PETITION

We present this petition for rehearing because we are so thoroughly satisfied that this is the kind of a case of which the Court would take jurisdiction if it realized what was involved in it that we are apprehensive that it did not appreciate it when it denied the petition for writ of certiorari. Especially are we apprehensive that the brief of amici curiae on behalf of the American Patent Law Association and the petitioner's reply brief may have been filed too late to receive consideration by the Court and the Court may have accepted the statement of the case and the questions involved in it found in the respondent's brief.

The statement of the case and the questions involved in it found in the respondent's brief are unqualifiedly erroneous. This is not "just another patent case". This is not a case like Minnesota Mining and Mfg. Co. v. Coe in which this Court denied a writ of certiorari on October 13, 1941. The petition in this case raised no questions as to the scope of appellate review in cases of this kind and presented no contention that commercial success of itself called for the grant of a patent.

The decision in this case contains a direct reversal of previous settled law, which reversal was necessary to refuse the patent asked. The severe miscarriage of justice, as it affects the petitioner, which in itself ought to be corrected, is nevertheless of very minor importance compared to the damage which such reversal of the law will inflict upon all inventors, all progressive industrial business both large and small, and the public in general.

## THE QUESTION THE PETITION PRESENTS

The question the petition presents and the only question it presents is whether a patent should be granted or denied in a case in which it is found as a fact that substantial well founded doubt of invention exists*, particularly if in addition to novelty and utility there appear overwhelming extraneous indicia of invention, always heretofore resorted to to resolve the doubt *in both obtaining and sustaining patents.*

In this case the Court of Appeals found that "the presence or absence of invention is doubtful" and its decision turned on its ruling on the question this petition presents. In Minnesota Mining and Mfg. Co. v. Coe there was no finding of doubt and the statement of the rule there advanced was pure *dictum.*

## THE BRIEF OF AMICI CURIAE AND THE PETITIONER'S REPLY BRIEF

If the brief of amici curiae and the petitioner's reply brief were filed too late to receive consideration by the Court it was in no degree the fault of the amici curiae or the petitioner. The brief amici curiae was, we understand, filed as soon as the consent of the counsel for the respondent could be obtained. The petitioner's reply

*The nature of the right conferred by the grant of a patent, and the necessity of resolving substantial well founded doubt of lack of invention in favor of the inventor-applicant are developed in the appendix.

brief was filed as soon as possible after the respondent's brief was served.

The reply brief completely riddled the wholly erroneous contentions of the respondent. The brief of amici curiae fully supports our contentions with respect to the respondent's brief and the case presented by our petition for writ of certiorari. Moreover, the mere fact that a brief amici curiae was filed on behalf of the American Patent Law Association demonstrates that what is involved in this case is not merely a matter of interest to the petitioner only but is a matter of interest and importance to inventors, industry, industry, large and small, and the country as a whole. If the petitioner's reply brief and the brief of amici curiae were filed too late for consideration by the Court prior to its decision on the petition for writ of certiorari in this cause, it is respectfully requested that they be considered in conjunction with this petition for rehearing. If they were before the Court when it considered the petition for writ of certiorari it is respectfully requested that they be reconsidered in conjunction with this petition for rehearing.

## CONFLICT WITHIN THE COURT OF APPEALS

That there are differences of opinion within the Court of Appeals for the District of Columbia with respect to the question presented by the petition for writ of certiorari in this cause, and that this case directly reversed previously settled law are evident from the following excerpts from the decisions of the Court of Appeals for the District of Columbia in this case and the case of *Thornton v. Coe*, 102 F. (2d) 247, 252

*This Case*

"Appellant urges that, although the appealed claims were finally rejected by the Examiner and the Board of Appeals in the Patent Office, claims as broad had previously been approved by two other Examiners. Appellant urges that the doubt thus created should be resolved in favor of the inventor, and against the Patent Office and District Court. *We agree that the presence or absence of invention is doubtful in this case.* But 'Whatever may be said of older decisions, that in appeals from the Patent Office *doubt was to be resolved in favor of the applicant*, they are obviously *not law in relation to appeals* from the District Court' ".

(Based on its own dictum)

*Thornton v. Coe*

"We think that Thornton's adjustability is such that *it cannot be said that want of invention is clear, and we may therefore properly resort to utility and commercial success to remove any remaining doubt* (citing Supreme Court decisions). It appears that the problem of spreading the heads of the warper beams confronted the textile industry for at least eight years after the issuance of the patent to Peterson, before Thornton solved it with the adjustable disk; and it appears that Thornton's improvement was a distinct success. *This is highly persuasive of invention.*"

(Based on Supreme Court authority)

(Italics supplied)

Thornton v. Coe, like this case, was an appeal from the District Court in an action under Sec. 4915, R. S. involving an ex parte application for patent. In this case all of the extraneous indicia of invention referred to in Thornton v. Coe were present. Obviously here are two antagonistic rules of law by the same Court, the final and only Court of Appeals in actions under Sec. 4915, R. S. where an ex parte appliction for patent is involved.

## CONCLUSION

A long established and universally settled rule of law not only of the United States Court of Appeals for the District of Columbia but all other Courts should not be overturned by three only of the six Justices of such United States Court of Appeals for the District of Columbia. It is most undesirable that the rule of decision to be followed in a case should depend upon the Court in which the case may be heard and, more so, in any Court, that the rule should depend upon which members of the Court hear the case; and it is fully as undesirable that there should be side by side two antagonistic rules of law.

We submit that this case presents a question which should be reviewed by this Court and we, therefore, make this request for rehearing of the petition for writ of certiorari and particularly do we request rehearing of the petition in the light of the brief of amici curiae and the respondent's reply brief.

Very respectfully,

GENERAL MOTORS CORPORATION,
By DRURY W. COOPER,
FRANK E. LIVERANCE, JR.,
*Counsel for Petitioner.*

Grand Rapids, Michigan.
December 11th, 1941.

## CERTIFICATE

It is hereby certified that the petition for rehearing is believed to be well-founded in law and fact and that it is made in good faith and not for any purpose of delay.

FRANK E. LIVERANCE, JR.

## APPENDIX

At first blush it may appear that the rule of resolving doubt of invention lack in favor of the applicant is anomalous and not justified. But a patent is a peculiar piece of property. *It is not a monopoly* carved out of the existing public domain and conferred on an individual.* It is a right granted in consideration of adding to the public domain. Practically, grant of a patent is merely giving a right to bring an action to establish the exclusive control for a short time of the addition to the public domain which the inventor has made. If the Court in which the action is brought finds that the supposed consideration for which the patent was granted did not exist or is insufficient it will dismiss the action. Therefore, nothing is taken from the public domain and no monopoly is created by the grant of a patent for an invention.

By filing a patent application an inventor applies for a right to bring action to establish his lawful title to what he conceives has been an addition to the public domain created by himself. In France, and other countries such application (for patent) for a right to sue to establish such title has been permitted as of course. By applying and disclosing the purported invention the applicant strips himself for all time of his natural right to keep to himself the new thing which he has created. Having taken such irrevocable step, he should not be denied the right to a day in Court to prove his title to the new thing which he has created unless it *clearly appears* that what he thought was new and inventive was not. And this is all the rule as to resolution of doubt of invention heretofore followed provides.

If in fact what the inventor thought he created clearly was *not new and inventive* then he should be and is denied a right to bring actions against others. There is

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*This is elementary. It is the first thing the elementary student of patent law reads in the first chapter of Walker on Patents (Sixth and other editions).

never any trouble when there is direct or substantial anticipation, for then there is no doubt that there is no novelty or invention and no excuse for giving the right to bring the action, — a patent. But if there is not such certainty, in other words, if there is substantial doubt, the right to bring action should be and always before has been given.

The resolving of substantial well founded doubt of invention in favor of the applicant is an essential to the existence of the patent system. Otherwise a patent cannot be obtained unless the inventor can prove beyond a doubt that what he created was of inventive character. This would be possible in few, if any, cases because unless the prosecution of the patent application was prolonged there would not be the opportunity for adequate commercial exploitation of the invention before the prosecution was terminated.*

Resolving substantial well founded doubt of invention in favor of the applicant to obtain the grant of a patent, which is only a right to bring suit and is not a conclusive holding of title, is a practical, workable rule and one which has worked successfully for better than 100 years. Certainly, when the Supreme Court itself has from time immemorial held that where the facts of the case show invention to be in doubt, resort may be had to the legal evidence and indicia of invention to resolve the doubt, there

*Even in such case, as with the Wilson invention in which the applicant's prosecution was prolonged, there was novelty and great and exclusive commercial exploitation and every evidential factor which resolves doubt in favor of invention was proven, the patent was refused because the Court did not hold invention proven beyond duobt. Evidently such ruling is going to make the Patent Office bureau an unrestrained czar in connection with patent applications. It can refuse patents that it wants to upon merely expressing someone's doubt of invention. There is establishment of bureaucratic domination of inventors. The servant becomes the master.

should at least on the same record which would sustain an issued patent be a grant of a patent so that the applicant shall not be irremediably foreclosed from a right to bring action to establish title to the property which he has created.

The rule of resolution of substantial well founded doubt as to invention is founded on a sound legal principle. A patent application with the prescribed oath makes a prima facie case of invention. The burden of showing lack of invention is thus put upon the Commissioner of Patents. And if the case made by him does no more than raise a doubt of invention it is obviously insufficient to overcome the presumption and the patent should be granted.

The rule of resolution of substantial doubt as to invention and the rule that an appellate tribunal will not disturb the decision of a lower tribunal because of mere doubt as to its correctness are separate, distinct and consistent rules. The former rule says that if absence of invention does not clearly appear the patent is to be granted. A finding by an appellate tribunal that "the presence or absence of invention is doubtful", therefore, establishes patentability and patentability having been established the decision denying patentability becomes manifestly erroneous and should be reserved.

The dispute in this case is not whether an invention is disclosed. A number of claims have been allowed an invention thus conceded. The dispute is whether the broader claims sought are within the *scope* of the invention. Claims are included in patents in compliance with the statutory requirement that what is considered the invention be particularly pointed out and distinctly claimed. It is settled that a patent comprehends nothing beyond the scope of its claims regardless of the actual scope of the invention. So refusal of claims commensurate in scope with the real invention is a refusal of a patent on the whole of the invention and irreparably damages the inventor. On the other hand the allowance of claims broader than the real invention is correctable. In the

first action in which they are asserted they will be held invalid or construed down to their proper scope.

In this case claims have been allowed and invention thus conceded. The question then is not as to the presence or absence of invention but as to the *scope* of the invention. Obviously it is more difficult to determine the scope of an invention than to determine whether there is an invention. The drafting of claims no more limited and no broader than the real invention, involving as it does consideration of all of the prior art and the employment of just the right words and expresions, is a very difficult job, particularly in a case like this where intangible rather than concrete mechanical elements are being dealt with. Therefore, we submit that especially in a case like this in which claims have been allowed and invention thus conceded and twice previously claims of identical scope with those in this case were granted, the rule of resolution of doubt of the lack of invention in favor of the inventor should be applied.

If the firmly established, practical, logical and essential rule of resolving substantial, well-founded doubt of lack of invention in favor of the applicant had been followed at any stage in the proceedings in this application the patent would have been allowed by any tribunal which handled it. The lower tribunals could not but have had substantial well-founded doubt of lack of invention and the Court of Appeals conceded and expressly found it based upon circumstances present in the case before the appealed claims were refused the first time by the third examiner, and which every tribunal of review had presented to it. To deny your petitioner a patent it was necessary in each instance that the established rule of resolution of such doubt be ignored and flouted (R. 446) until the Court of Appeals, recognizing the settled rule reversed it and pronounced a diametrically opposite rule.

If all that is involved in this case was whether or not a patent should be granted on this application, this petition for certiorari would not, in all likelihood, have been filed. Not that the petitioner's interest in the application would

have been any less, but it would have probably been considered a futile gesture because of interest only to the petitioner. But much more became involved in this case when the Court of Appeals sitting in this case announced its rule regarding doubt of lack of invention, overturning and reversing that theretofore universally followed. This pronouncement of the opposite rule and the decision of this case on that opposite rule changed this case from one which might have affected the interest of the petitioner alone to one which changed the patent law and threatens to destroy the whole patent system of this country. For this reason it was earnestly believed that the importance of the case and the nature of the questions involved were such that this Court would entertain a petition for writ of certiorari. The general interest and importance to inventors and owners of applications for patent on inventions is demonstrated by the intervention and vigorous attack by the American Patent Law Association in this case upon such reversal of established law.

A very long step in the direction of seriously crippling, if not substantially destroying, the patent system has been taken by the Court of Appeals for the District of Columbia in this case.

To develop and make available to the public new products is time consuming and expensive. Giving to inventors the opportunity to reimburse themselves for the time and money spent and receive reward for the inventions made is the incentive for producing inventions, thus insuring the technological and social progress of the country. It is the wise purpose of the Constitutional provision with respect to patents and the patent laws that the inventors shall be protected and thus encouraged to promote the sciences and useful arts. The Constitutional provision and statute based thereon should not be allowed to be nullified without mature serious thought and consideration and certainly not without the direct passing thereupon by the highest Court.